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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,094	04/11/2005	Mohammad Jamal El-Hibri	260267US0X PCT	6221
22850	7590	10/03/2007	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.			TRUONG, DUC	
1940 DUKE STREET			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314			1711	
			NOTIFICATION DATE	DELIVERY MODE
			10/03/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/511,094

Applicant(s)

EL-HIBRI, MOHAMMAD JAMAL

Examiner

Duc Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 28-53 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>020305</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 28-31,33-35,37-41,43-45, and 48-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Beverly (3,755,256) of record on 1449 or GB 1398133 (new citation).

The reference discloses aromatic polysulfones such as the claimed bisphenol A polysulfone (see col. 4, example 4) containing phosphorus compounds to increase melt stability (see examples, claims)

Note that the reference further discloses that the compositions may contain dye and pigments (see col. 2, lines 43-44).

GB 1398133 discloses aromatic polysulfones (see pages 1-3) can be mixed with organic phosphorus compound by extrusion or in a sigma bladed mixer or in a two roll mill, or by mixing a solution of the phosphorus compound with powdered polymer followed by drying in the presence of dyes and pigments (see pages 1-3)

Claims 28,31,32, 35,36, 39-42,45, and 48-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Stevenson et al (5,438,086) of record on 1449.

The reference discloses the use of pentaerythritol diphosphates as additives in polysulfones (see Abstract, col.3, line 52, line 58; col. 9, lines 19-23), and function as

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desired for color stability and melt flow stabilization (see col. 3, lines 16-19), and other additives such as optical brighteners---(see col. 23, line 46).

Claims 28,31-32,35-36,39-42,45, and 48-53 are rejected under 35 U.S.C. 102(b) as being anticipated by US2001/0053805 of record on 1449.

The reference discloses phosphorus containing stabilizers for organic materials such as Polyethersulfone (see Abstract, [0048], [0043] and the use of other additives such as optical brighteners---[0066], claims 1 and 6.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 47 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Beverly or Stevenson et al or US 2001/0053805, they are of record on 1449.

The references disclose the claimed compositions, as stated above.

The disclosures of the references differ from the instant claim in that they do not disclose the claimed characteristics.

However, the compositions disclosed by the references are prepared from reactants under process conditions that are inclusive of the claimed reactants and conditions. In view of this similarity, it would appear to be inherent that a product having the claimed properties could be prepared following the teachings of the references. See *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

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Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beverly or Stevenson or US 2001/0053805.

The references disclose the claimed compositions, as stated above.

The disclosures of the references differ from the instant claim in that they do not disclose the claimed 5,7-di-t-butyl-3-(3,4-dimethylphenyl)-3H-benofurane-2-one.

However, the references do disclose other additives in that the claimed component, as stated above, is included. Therefore, it would have been obvious to one of ordinary skill in the art to select any additives from the references within the claimed component since they have been shown to be effective in a similar system and thus would have been expected to provide adequate results. There is no showing of unexpected results derived from said selection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 28-53 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-44 of copending Application No. 10/510,707. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference is the claimed polyarylethersulfone of 10/510,707 is included in the broad polysulfone of the instant claims.

Therefore, it would have been obvious to one of ordinary skill in the art to select the species in claims of the reference to replace the broad polysulfone of the instant claims to get the same or similar products in the absence of a showing of unexpected results derived from said selection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Truong whose telephone number is 571-272-1081.

The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Duc Truong', with a stylized flourish at the end.

DUCTRUONG
PRIMARY EXAMINER